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No. 00-

IN THE

Supreme Court of the United States

ARTHUR S. KOENIG and MDI LABS, INC.,

Petitioners,

v.

FUGRO-McCLELLAND (SOUTHWEST), INC. and PHILIP KING,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

PETITION FOR A WRIT OF CERTIORARI

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QUESTION PRESENTED

The patent claims that define the property right granted to Arthur S. Koenig in United States Letters Patent 5,076,392 include the term "positively engaging." Within the context of the patent, "positive engagement" simply refers to a secure connection between two parts such that one part does not move relative to the other.

In interpreting the claim language, the lower court held that "positively engaging" should not be given its ordinary meaning because the patentee, in his remarks to the patent examiner, purportedly redefined the term from the ordinary meaning used in the patent to something else. The important question presented — essential to *all* patents and their proper interpretation — is:

Can the heavy presumption in favor of the ordinary meaning of patent claim language be overcome merely by the patentee's remarks taken out of context from the patent prosecution file history?

STATEMENT PURSUANT TO RULE 29.6

With respect to Petitioner MDI Labs, Inc., there is no parent corporation or any publicly held company that owns ten percent or more of the Petitioner's stock.

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Appendix C — Order Of The United States District Court For The Western District Of Texas, San Antonio Division Dated And Filed January 27, 1998 ..... 23a

Arthur S. Koenig and MDI Labs, Inc. (collectively referred to as "Koenig") respectfully pray that a writ of certiorari issue to review the judgment and opinion of the United States Court of Appeals for the Federal Circuit entered in this proceeding on June 2, 2000, in order to decide a question fundamental to the patent system and to resolve a conflict between panels of the Federal Circuit Court of Appeals on the important issue presented herein.

OPINIONS BELOW

The opinion of the United States Court of Appeals for the Federal Circuit that gives rise to this petition is unpublished by order of the Federal Circuit. It is reprinted in Appendix A hereto ("App. A") at page 1a. By order filed June 29, 2000, the Federal Circuit denied the petition for rehearing. App. B, 22a. The relevant district court opinions are unreported but include the January 27, 1998, opinion and order of the district court granting Defendants' Motion for Summary Judgment (App. C, 23a) and the magistrate judge's recommendation of June 30, 1997.[1]

STATEMENT OF JURISDICTION

The Federal Circuit affirmed the judgment of the district court in an opinion filed June 2, 2000. On June 29, 2000, the Federal Circuit denied Koenig's timely filed petition for rehearing. App. B, 22a. Pursuant to Supreme Court Rule 13.1, this Petition has been filed within ninety days of the denial of rehearing.

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1. The Memorandum and Recommendation of United States Magistrate Judge dated June 30, 1997, is being simultaneously filed with the clerk as Exhibit A to the Motion for Leave to Lodge Memorandum and Recommendation of United States Magistrate Judge Under Seal Pursuant to Protective Order.

The jurisdiction of the Court is invoked pursuant to 28 U.S.C. § 1254(1).

STATUTE INVOLVED

This petition does not involve interpretation of any Constitutional provision, but does involve interpretation of patent claims under 35 U.S.C. § 112 (1975). Section 112, ¶ 6, as amended in 1975, provides:

> An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material or acts described in the specification and equivalents thereof.

STATEMENT OF THE CASE

Arthur Koenig of San Antonio, Texas, is the inventor and owner of United States Patent 5,076, 392 ("the '392 patent") issued December 31, 1991. The patent discloses and claims inventions for sampling soil beneath the foundation of a building. Mr. Koenig is also an owner of MDI Labs, Inc., a small Texas-based company licensed under the '392 patent that manufactures the patented soil sampling machine and performs soil sampling services throughout South Texas.

Fugro-McClelland (Southwest), Inc. is a Texas corporation that performs competing soil testing and analysis. Philip King is an engineer and supervisor in Fugro's San Antonio office.

The '392 patent teaches that in using the patented machine and methods, a machine operator need only drill one hole in the foundation of the building. The same hole is used not only for passage of a sample tube through the slab into the soil below, but also to securely fasten the machine to the foundation, i.e., to positively engage the foundation. The patent discloses various anchoring mechanisms positionable in the hole for "positively engaging" the load bearing strata (such as a concrete slab in the foundation). The claims of the '392 patent recite these different anchoring mechanisms in means-plus-function form as follows:

> means positionable in a hole . . . for ***positively engaging*** a load bearing strata and having an opening therethrough for passage of the [soil sample] member when said member forcing means is activated. . . .[2]

"Positively engaging" within the context of the '392 patent simply means "securely fastening to." The term is used throughout the '392 patent specification consistent with this plain language meaning of the words. No special meaning was ever given to the term in either the written description or claims of the patent.

The fighting issue on summary judgment was whether Fugro's anchoring mechanism satisfied the means-plus-function limitation "means . . . for positively engaging a load bearing strata" of the patent claims. In order to affirm the district court's grant of summary judgment of noninfringement, the Federal Circuit moved away from the

2. This claim language is recited in claim 22 of the '392 patent. Claims 1-11 and 18-20 recite similar variants of this "means . . . for positively engaging" limitation.

passage of the member when said member forcing means is activated; and

means mounted to said line of action selecting means for engaging said material engaging means to resist movement of said line of action selecting means with respect to the material along the line of action upon activation of said member forcing means by transmitting to the material the reactive forces resulting from the forcing of the member within the material.

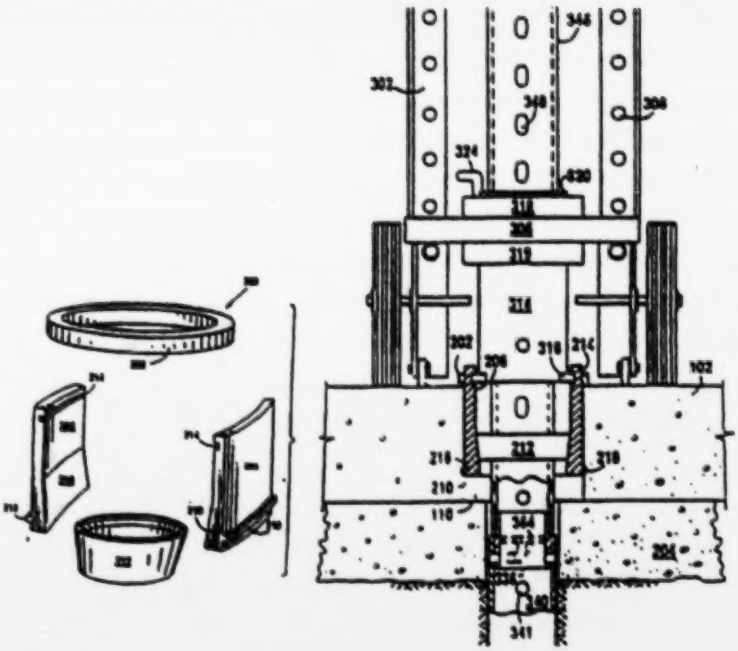
'392 patent, col. 23, lines 29-42 (paragraphing and emphasis added). Claim 18 is similar, and provides in relevant part:

18. *means . . . for positively engaging* a hole within the load bearing strata to transmit to the material the reactive forces resulting from the forcing of the sample tube into the material . . . thereby preventing movement of said derrick with respect to the load bearing strata.

Id., col. 24, line 64 – col. 25, line 6 (emphasis added). The anchoring mechanism is further claimed in different language in the other independent and dependent claims.

The specification describes a large number of anchoring mechanisms, of which the preferred embodiment — designated collar 200 — is illustrative. Collar 200, pictured below, is comprised of circular collar pieces, which approximate the shape of the hole and are held in place by a bushing that forces the collar pieces towards the side of the hole.

Appendix A



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The outer surface of the collar — the surface in contact with the wall of the hole — is provided with a protruding "lip" that slots into a groove or discontinuity in the wall of the hole for the purpose of transferring the force of drilling to the wall of the hole, and ultimately keeping the drilling derrick from being pulled into or pushed out of the hole when the sample tube is inserted or extracted, respectively. *See id.*, col. 9, lines 10-16; Figs. 6 and 7. The specification describes several additional collar structures that encircle the wall of the hole and interact with a groove or discontinuity in the wall of the hole through a variety of structures, *see e.g., id.* at Fig. 8 (spring wedged between collar and

discontinuity), Fig. 9 (spring extended through slot in collar into discontinuity), and discloses a special tool for carving a groove in the side of the hole. *See id.* at Fig. 2. The mechanism by which collar 200 transmits the force of drilling into the load bearing strata is described as introducing an "interference," which may be in the form of lips 218, which may be placed in groove 216 or another kind of discontinuity to cause "lock up" to be achieved. *See id.* at col. 11, lines 29-40.

In addition, the specification provides:

> In some applications, the reactive forces can be better transmitted to strata 102 by mounting a cylinder (not shown) having a radially extending plate at the bottom end thereof to the threads 320 in locking dog 314 in place of nut 319. The plate transmits force to strata 102 around the same radius as the force transmitted through the lip 218 of collar 200 and discontinuity 216, and the cylinder can be screwed downwardly into engagement with strata 102 to effectively place the portion of strata 102 between lip 218 and the plate into compression rather than tension.

'392 patent, col. 21, lines 34-44.

Koenig argues that this embodiment anchors the drilling derrick by clamping the wall of the hole between the upper radially-extending plate on the top surface of the hole, and the lower lip which is inserted into a discontinuity or groove in, or below, the wall of the hole.

Appendix A

During the prosecution of the '392 patent, the PTO rejected all of the claims in the Office Action dated June 1, 1989, as anticipated by the cited prior art. One of the cited references was the Langenbach patent, which discloses an apparatus for shoring up a foundation in which a foundation engaging means is secured to a hole in the foundation, and a piling means is driven into the underlying strata. The patent discloses a foundation engaging means which consists of a "split tubular member" which fits into the hole and has upper and lower "lips" that appear to clamp the top and bottom of the foundation. The rejection stated:

> Each of the primary references disclose substantially all of the claimed subject matter of engaging and anchoring drilling equipment to the soil except specifically transmitting reactive forces to the soil.
>
> If the transmitting of reactive forces is not inherently [sic] to these references, merely transmitting reactive forces is notoriously well known . . . .

Koenig responded:

> Applicant desires to call attention to the definition in the specification of the phrases "reactive force" and "positive engagement" which appear in the claims. As taught so eloquently in *Autogiro Company of America v. U.S.* (384 F.2d 391, 397 (Ct. Claims 1967)), . . . patent law allows the inventor to be his own lexicographer." . . . [I]t

> is believed that reference to [these definitions] is essential to an understanding of how the claims as filed define an invention which is not anticipated by the cited references.
>
> "[P]ositive engagement" of strata 102 is achieved by the interaction of the collar 200 with a discontinuity, such as the groove 216, in the wall of hole 110 which "prevents axial movement of collar 200 in hole 110 regardless of the direction of the reactive forces applied thereto."
>
> The phrase "reactive force" is defined at various places throughout the specification. For instance . . . it is stated that the collar 200 resists the reactive forces "which cause movement either away from or down into strata 102 when force is applied thereto."

Koenig also described the mechanism of resisting reactive forces as "introducing an interference to carry shear force between the wall of the hole 100 and the collar 200 to cause lock-up to be achieved," and noted that collar 200 engages the discontinuity in the side of the hole to transmit the reactive force.

Koenig concluded the response with the following statement:

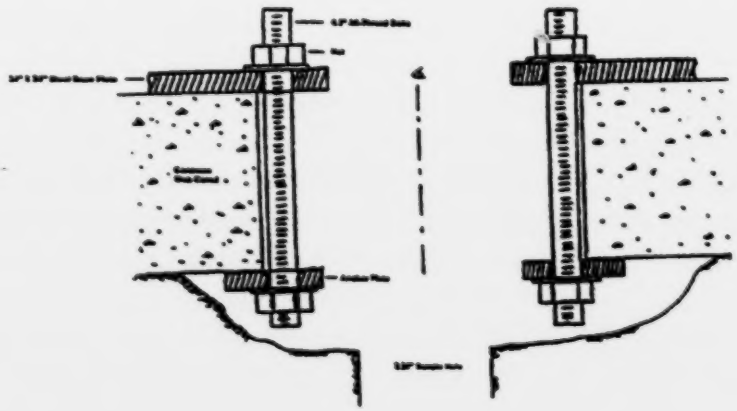
> The assertion that each of these three references discloses "substantially all the claimed subject matter" on page 4 of the Office Action is

> respectfully traversed. As described above, none includes a disclosure of a discontinuity in a hole in a strata such that none can teach . . . means for positively engaging the material comprising the strata (claims 1 and 18) or means for positively engaging the strata through which the member is to be forced into the material comprising the strata passes (all claims).

Following Koenig's response, the PTO withdrew the rejections, and eventually the patent issued.

B

Koenig operates a small soil-sampling business in San Antonio and Corpus Christi, Texas, and serves a variety of customers, including Fugro. In early 1995, after Koenig had performed a number of sampling jobs for Fugro, Fugro began performing the sampling itself using the accused soil-sampling machine that it built for this purpose. Fugro's machine is anchored as illustrated below.



First, a hole is drilled in the foundation, and some of the soil below the foundation is removed. The drilling machine is then clamped to the foundation using four threaded bolts that are fixed at one end in the steel base plate of the drilling machine, and fixed at the other end in a steel anchor plate placed against the underside of the foundation. The parties disagree whether any of the claims of the '392 patent read on this clamping structure.

Koenig filed suit alleging that the Fugro machine infringed the '392 patent, and further asserting that Fugro misappropriated trade secrets relating to Koenig's drilling operation. Fugro counter-claimed, asserting that the '392 patent was invalid under 35 U.S.C. § 112 ¶ 1 (1994) for failure to set forth the best mode of practicing the invention, or under the on-sale or public use bars of 35 U.S.C. § 102(b). Following a *Markman* hearing, the magistrate judge construed the disputed claim limitation, "means for positively engaging." The parties then filed motions for summary judgment before the magistrate judge. The district court adopted the magistrate judge's recommendation to grant Fugro's motion for summary judgment that claims 1-11, 18-20, and 22 of the '392 patent were not infringed, either literally or under the doctrine of equivalents. The magistrate judge further recommended that Fugro's motion for summary judgment of invalidity of the '392 patent be denied. The district court adopted the magistrate's recommendations. This appeal followed, vesting this court with jurisdiction pursuant to 28 U.S.C. § 1295(a)(1) (1994).

Appendix A

II

We review a district court's grant of summary judgment without deference. *See Johnson Worldwide Assocs., Inc. v. Zebco Corp.*, 175 F.3d 985, 988, 50 USPQ2d 1607, 1609 (Fed. Cir. 1999). Summary judgment is only appropriate if there is no genuine issue of material fact. *See* Fed. R. Civ. Proc. 56(c). To this end, the court must draw all reasonable factual inferences in favor of the nonmovant. *See Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 255 (1986). In reviewing a grant of summary judgment of noninfringement, as with any infringement inquiry, we must first determine the correct claim scope as a matter of law. *See Renishaw PLC v. Marposs Societá per Azioni*, 158 F.3d 1243, 1247-48, 48 USPQ2d 1117, 1120 (Fed. Cir. 1998). We then compare the properly-construed claim to the accused device to determine, as a matter of fact, whether all claim limitations are present in the accused device, either literally or under the doctrine of equivalents. *See id.*

A claim limitation written in means-plus-function form, reciting a function to be performed rather than definite structure, is subject to the requirements of 35 U.S.C. § 112, ¶ 6 (1994). *See B. Braun Med., Inc. v. Abbott Labs.*, 124 F.3d 1419, 1424, 43 USPQ2d 1896, 1899 (Fed. Cir. 1997); *Odetics, Inc. v. Storage Technology Corp.*, 185 F.3d 1259, 1266, 51 USPQ2d 1225, 1229 (Fed. Cir. 1999). As such, the limitation must be construed "to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." 35 U.S.C. § 112, ¶ 6; *B. Braun*, 124 F.3d at 1424, 43 USPQ2d at 1899. The determination of the claimed function and corresponding

structure, being a matter of the construction of specific terms in the claim, is a question of law, which this court reviews without deference. *See Chiuminatta Concrete Concepts, Inc. v. Cardinal Indus., Inc.*, 145 F.3d 1303, 1309, 46 USPQ2d 1752, 1755-56 (Fed. Cir. 1998).

At issue in this appeal is the "means for positively engaging" limitation found in independent claims 1, 18 and 22.[1] The district court did not treat this limitation as a means-plus-function claim subject to the requirements of section 112, ¶ 6, and construed "positively engaging" to "require both prevention of up and down movement and lock-up with the wall of the hole." Both parties assert that the critical "means for positively engaging" limitation is in means-plus-function form, subject to the requirements of 35 U.S.C. § 112, ¶ 6 (1994). The parties disagree, however, as to the meaning of the term "positively engaging."

We agree that this limitation is in means-plus-function form, *see Micro Chemical, Inc. v. Great Plains Chemical Co., Inc.*, 194 F.3d 1250, 1257, 52 USPQ2d 1258, 1265 (Fed. Cir. 1999); *Al-Site Corp. v. VSI Int'l. Inc.*, 174 F.3d 1308, 1314 1318, 50 U.S.P.Q.2d 1161, 1166 (Fed. Cir. 1999), and that the district court erred when it did not analyze the claim under section 112, ¶ 6. This error is harmless, however, because the same result is required under the proper claim construction.

The first step in analyzing a claim written in means-plus-function form is to identify the claimed function.

---

1. Koenig does not independently argue that claims 2-10 and 19-20 are infringed by Fugro's device.

See Chiuminatta, 145 F.3d at 1308, 46 USPQ2d at 1755. We agree with the parties that the claimed function in this disputed limitation of representative claim 1 is "positively engaging." The next step is to construe the meaning of the words used to describe the claimed function, using ordinary principles of claim construction. Terms in a claim are to be given their ordinary and accustomed meaning, within the context of the claim. *See Johnson Worldwide*, 175 F.3d at 989-90, 50 USPQ2d at 1610. The heavy presumption in favor of the ordinary meaning of claim language is overcome if the meaning of the term is unclear from the context of the claim, *see id.*, or if the patentee has chosen to be his or her own lexicographer by clearly setting forth an explicit definition for a claim term. *See id.*; *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994) (applicant may act as his own lexicographer, but definition must be done with "reasonable clarity, deliberateness and precision"); *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1387-88, 21 USPQ2d 1383, 1386 (Fed. Cir. 1992) ("[w]here an applicant chooses to be his own lexicographer and to give terms uncommon meanings, he must set out his uncommon definition in some manner within the patent disclosure so as to give one of ordinary skill in the art note of the change"); *Lear Siegler, Inc. v. Aeroquip Corp.*, 733 F.2d 881, 888-89, 221 USPQ 1025, 1031 (Fed. Cir. 1984) (same).

Koenig argues that the ordinary meaning of "positively engaging" controls in this case, and sets forth that meaning as "resisting of axial movement." This is a case, however, in which the heavy presumption in favor of the ordinary meaning is overcome because the patentee has chosen to act

as his own lexicographer and present a clear alternative definition for "positively engaging". *See Paulsen*, 30 F.3d at 1480, 31 USPQ2d at 1674; *Intellicall*, 952 F.2d at 1387-88, 21 USPQ2d at 1386. During prosecution, a rejection was made under 35 U.S.C. §§ 102(b) and 103 over several prior art references, including the Langenbach reference. Arguing against the prior art, Koenig proclaimed his right to act as his own lexicographer, stating "[a]s taught so eloquently in *Autogiro Company of America v. U.S.*, . . . patent law allows the inventor to be his own lexicographer." Koenig then defined "positively engaging" and "reactive force" in terms of the structure and function of collar 200, the preferred embodiment. Specifically, Koenig stated that positive engagement is achieved by the interaction of collar 200 with the discontinuity in the wall of the hole so that axial force is resisted. Koenig added, when defining "reactive force," that this interaction introduces an interference so that "lock-up" is achieved. From these definitions, we conclude, as did the district court, that "positively engaging" requires (1) resisting axial movement by the interaction of a collar with a discontinuity or groove in the wall of a hole; and (2) introduction of an interference so that "lock-up" is achieved.

Koenig argues, however, that the district court erred by reading into the claims limitations from the preferred embodiment, collar 200, based on remarks made by Koenig during prosecution. According to Koenig, applicant sought to "clarify" the meaning of "reactive forces, in the context of discussing "positively engaging." We disagree with this re-characterization of Koenig's statements during the prosecution of the '392 patent. During prosecution, Koenig

defined "positively engaging" by explicitly referencing the preferred embodiment, collar 200. This definition was presented with the requisite "reasonable clarity, deliberateness, and precision," *Paulsen*, 30 F.3d at 1480, 31 USPQ2d at 1674, and Koenig further referenced his definition when arguing over the asserted prior art. Having advanced this definition during prosecution, Koenig may not now assert a broader meaning for the term.

III

Next, we turn to the issue of whether Fugro's device literally infringes the asserted claims of the '392 patent. Literal infringement of a section 112, ¶ 6 limitation requires that the relevant structure in the accused device perform the identical function recited in the claim and be identical or equivalent to the corresponding structure in the specification. *See Odetics*, 185 F.3d at 1266, 51 USPQ2d at 1229; *Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931, 934, 4 USPQ 2d 1737, 1739 (Fed. Cir. 1987) (en banc) ("To determine whether a claim limitation is met literally, where expressed as a means for performing a stated function, the court must compare the accused structure with the disclosed structure, and must find equivalent structure as well as identity of claimed function for that structure." (emphasis in original omitted).) Identity of function must first be established before reaching the statutory equivalence analysis. *See Odetics*, 185 F.3d at 1267, 51 USPQ2d at 1229. The statutory equivalence analysis then requires determination of whether the asserted infringing structure performs the claimed function in substantially the same way to achieve substantially the same result as the corresponding

structure described in the specification. *See id.* Whether an accused device infringes section 112, ¶ 6 as an equivalent is a question of fact. *See id.* at 1268, 51 USPQ2d at 1230; *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1363, 48 USPQ2d 1225, 1241 (Fed. Cir. 1988).

We conclude that no reasonable jury could find that Fugro's accused clamp device performs the claimed function. Fugro's expert testified that the Fugro clamp does not fit against the wall of the core hole. Instead, the Fugro device clamps the foundation between a top plate resting on top of the slab, and a bottom plate resting against the bottom of the slab, and the only parts of the Fugro device that are within the hole are the bolts, which do not contact the side of the hole at all. Accordingly, we conclude that Fugro's clamp does not prevent axial movement by interacting with a groove or discontinuity in the wall of the hole via a lip or lip-like structure, and thus that it does not perform a function identical to the claimed function.

Koenig asserts, however, that at the very least a material issue of fact exists as to whether the Fugro device performs the claimed function, based on its experts' testimony that the upper and lower plates of the Fugro's clamp touch the wall of the hole as they rest on top of and below the foundation. According to those experts, this contact creates lock-up, and therefore the Fugro clamp transfers reactive forces by contact with the wall creating a lock-up. This testimony merely opines that Fugro's clamp touches the top of the hole, and does not address at all whether the clamp transfers reactive force through the interaction of a lip or lip-like structure with a discontinuity or groove in the wall

of the hole. For this reason, the testimony cannot create a material issue of fact that precludes the grant of summary judgment on this issue.

Because we conclude that no reasonable jury could find that the accused clamp structure functions identically to the claimed function, we affirm the district court's grant of Fugro's motion for summary judgment that the claims of the '392 patent are not literally infringed by the Fugro device. Thus, we need not reach Fugro's arguments that its clamp does not have equivalent structure to the claimed structure, and that the clamp does not read on the "positionable in a hole" and "means for engaging the material engaging means" limitations in claims 1-11 and 22. *See Laitrim Corp. v. Rexnord, Inc.*, 939 F.2d 1533, 1535, 19 USPQ2d 1367, 1369 (Fed. Cir. 1991) ("[T]he failure to meet a single limitation is sufficient to negate infringement of the claim.").

IV

A claim that does not literally read on an accused device may nevertheless be infringed under the doctrine of equivalents if the differences between the claimed and accused devices are insubstantial. *See Warner-Jenkinson Co. v. Hilton-Davis Chem. Co.*, 520 U.S. 17, 21 USPQ2d 1865, __ (1997). Although under section 112, ¶ 6, the lack of equivalent structure will preclude a finding of equivalence under the doctrine of equivalents, *see Kemco Sales, Inc. v. Control Papers Co., Inc.*, 2000 WL 354768,*9 (Fed. Cir. 2000) (a structure failing the section 112, paragraph 6 test under either or both of the "way" or "result" prongs must also fail the corresponding doctrine of equivalents test

unambiguous, ordinary meaning of "positively engaging" used in the patent document to a narrow, specialized meaning that would dispose of the case.[3] Based solely on Koenig's remarks in distinguishing his invention from the prior art as part of the file history, the court concluded that "positively engaging" requires "(1) resisting axial movement by the interaction of a collar with a discontinuity or groove in the wall of the hole; and (2) introduction of an interference so that 'lock-up' is achieved." App. A, 14a.

Koenig's petition for rehearing was denied. App. B, 22a.

REASONS FOR GRANTING THE WRIT

I. The Federal Circuit's Decision — Which Undermines the Ordinary Meaning of Patent Claim Language — Directly Conflicts with Its Prior Precedent and Is Contrary to this Court's Decision in *Markman*

The decision below is in direct conflict with prior case law regarding the patentee's right to be his own lexicographer and the heavy presumption in favor of the ordinary meaning of claim language. As the Federal Circuit acknowledged in *Markman*, "a patentee is free to be his own lexicographer. . . . The caveat is that any special definition given to a word must be clearly defined *in the specification*." *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980 (Fed. Cir. 1995), *aff'd*, 517 U.S. 370, 116 S. Ct. 1384, 134 L. Ed. 2d 577 (emphasis added). In fact, the court of exclusive appellate jurisdiction in patent cases has consistently held that any special definition

3. In so doing, the Federal Circuit provided a claim construction different from the constructions advanced by the parties, effectively denying Koenig an opportunity to present evidence and create a fact issue on infringement based upon this new claim construction.

of a claim term that departs from its ordinary meaning must be clearly set forth *in the patent specification*. *See, e.g., Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1477 (Fed. Cir. 1999) (recognizing that "a special meaning . . . must be sufficiently clear in *the specification* that any departure from common usage would be so understood by a person of experience in the field of the invention"); *Gentex Corp. v. Donnelly Corp.*, 69 F.3d 527, 530 (Fed. Cir. 1995) (emphasizing that "[w]ords in claims are to be given their ordinary meaning in the absence of indication *in the patent* to the contrary"); *Beachcombers Int'l., Inc. v. Wildwood Creative Prod., Inc.*, 31 F.3d 1154, 1158 (Fed. Cir. 1994) (explaining that "a patentee can be his own lexicographer provided the patentee's definition, to the extent it differs from the conventional definition, is clearly set forth *in the specification*"); *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (noting that "[w]here an inventor chooses to be his own lexicographer and to give terms uncommon meanings, he must set out his uncommon definition in some manner *within the patent disclosure* so as to give one of ordinary skill in the art notice of the change"); *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1388 (Fed. Cir. 1992) (holding that an inventor "must set out his uncommon definition in some manner *within the patent disclosure*"). Simply put, if a patentee elects to be his own lexicographer, he must set forth the uncommon or special definition *in the patent specification*.

The decision below flies in the face of this long-standing precedent. The Federal Circuit conceded that the term "positively engaging" was used throughout the written description and patent claims consistent with its ordinary meaning understood by those skilled in the art. App. A, 13a. And yet the lower court construed the claim language contrary to its ordinary meaning based upon statements made in the file history.

Reliance on the prosecution history to support a finding that the patentee provided a special definition for a claim term at variance with that given in the specification also runs contrary to the axiom that terms must be used consistently in the claims and specification. *See Fonar Corp. v. Johnson & Johnson*, 821 F.2d 627, 632 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1027, 108 S. Ct. 751, 98 L. Ed. 2d 764 (1988) (noting that "[t]hough inventors may be their own lexicographers, they must use words in the same way in the claims and the specification"). The lower court's failure to adhere to its prior precedent under the principle of *stare decisis* alone warrants grant of the writ.

Moreover, the lower court decision is contrary to the principles of patent claim construction pronounced by this Court in its seminal decision in *Markman*. This Court emphasized in *Markman* that a "necessarily sophisticated analysis of the whole [patent] document [is] required by the standard construction rule that *a term can be defined only in a way that comports with the instrument as a whole*." 517 U.S. 370, 389, 116 S. Ct. 1384, 1395, 134 L. Ed. 2d 577 (1996) (emphasis added). In the present case, the purported special definition does not comport with the patent instrument as a whole. The lower court admitted as much. App. A, 14a. Nor, given that definition, is the specification consistent with itself. These crucial facts notwithstanding, the Federal Circuit still ascribed a special definition to the claim language.

In effect, the Federal Circuit relied on the patentee's statements made in support of patentability during the prosecution history as a basis to redraft the claim language. This the court cannot do. As this Court explained long ago, the language through which claims are expressed is not

"a nose of wax, which may be turned and twisted in any direction" into a form that pleases and that produces a particular result a court may desire. *White v. Dunbar*, 119 U.S. 47, 51, 7 S. Ct. 72, 74 (1886).[4] The ordinary meaning of claim language controls unless there is an absolutely unequivocal contrary definition by the patentee in the patent specification. In the instant case, review of the patent specification reveals no such special definition.

When the claim language "positively engaging" is properly construed and given its ordinary meaning within the context of the patent, identity of function exists and issues of fact remain as to equivalency of structure under 35 U.S.C. § 112, ¶ 6. Accordingly, summary judgment of noninfringement was improperly granted — fact issues on infringement remain for a jury determination.

---

4. It was necessary for the Federal Circuit to depart from the ordinary meaning of "positively engaging" to affirm the summary judgment of noninfringement. The court's construction was narrower than the district court's construction and different from any construction advanced by the parties. Yet, Koenig was not afforded an opportunity to present evidence of infringement based upon the new construction, raising serious due process concerns. This case demonstrates the inherent prejudice to litigants when courts go beyond the ordinary meaning of the claim language, issuing a claim construction never contemplated by the parties.

II. The Federal Circuit's Decision Is Contrary to the Main Purposes of the Patent System, Creating Uncertainty in the Public as to Limits of Patent Rights and Denying Inventors the Rightful Rewards for Their Disclosures

It has been long understood that a patent must describe the exact scope of an invention to "secure to [the patentee] all to which he is entitled, [and] to apprise the public of what is still open to them." *McClain v. Ortmayer*, 141 U.S. 419, 424, 12 S. Ct. 76, 77, 35 L. Ed. 800 (1891). Under the modern American patent system, these objectives are served by two distinct elements of a patent document. First, a patent contains a specification describing the invention "in such full, clear, concise, and exact terms as to enable any person skilled in the arts . . . to make and use the same." 35 U.S.C. § 112, ¶ 1. Second, a patent includes one or more "claims" which "particularly point out and distinctly claim the subject matter which the applicant regards as his invention." 35 U.S.C. § 112, ¶ 2. *See Markman,* 517 U.S. at 373, 116 S. Ct. at 1387-88.

As the Court noted in *General Elec. Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 369, 58 S. Ct. 899, 902, 82 L. Ed. 1402 (1938), "[t]he limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others and the assurance that the subject of the patent will be dedicated ultimately to the public." Otherwise, a "zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement . . . would discourage invention only a little less than unequivocal foreclosure of the field," *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 236, 63 S. Ct. 165, 170, 87 L. Ed. 232 (1942), and "[t]he public [would] be deprived

of rights supposed to belong to it, without being clearly told what it is that limits these rights." *Merrill v. Yeomans*, 94 U.S. 568, 573, 24 L. Ed. 235 (1877).

Proper claim interpretation is essential to the American patent system. The claims define the metes and bounds of the patent to put the public on notice of the monopoly grant. Additionally, patent claims must be correctly interpreted in order to give the patentee his rightful reward for his disclosure. For these reasons, the ordinary meaning of claim language must control unless the patentee has clearly and precisely provided an uncommon definition for the language *in the patent itself*. To hold otherwise only creates indefiniteness for the public in ascertaining the scope of the patent rights in their attempts to design around the patent. Certainty to the patent system necessarily means that the "heavy presumption" in favor of the ordinary language cannot be circumvented merely by statements buried in a file history — especially where the court's "special definition" is at odds with the patent itself.

Unfortunately, the Federal Circuit's departure from the "heavy presumption" in favor of the ordinary meaning of claim language in this case is not an anomaly. In other panel decisions the Federal Circuit has shown no reluctance to stray from the ordinary meaning based solely upon statements made in the prosecution history. (*See, e.g., K-2 v. Saloman S.A.*, 191 F.3d 1356, 1363 (Fed. Cir. 1999)) (noting that "a different meaning clearly and deliberately set forth in the intrinsic materials — written description *or the prosecution history* — will control"); *Transmatic, Inc. v. Gulton Indus., Inc.*, 53 F.3d 1270, 1277 (Fed. Cir. 1995) (remarking that "claim terms are given their ordinary and accustomed meaning unless examination of the . . . prosecution history

. . . indicate[s] otherwise." The need for harmony and consistency in the patent laws compels the Court grant the writ to resolve the internal conflict between panels of the lower court. It was for the sake of uniformity that Congress created the Court of Appeals for the Federal Circuit as an exclusive appellate court for patent cases, observing that increased uniformity would "strengthen the United States patent system in such a way as to foster technological growth and industrial innovation." H.R. Rep. No. 97-312, p. 20 (1981). Uniformity would, however, be ill served by allowing the Federal Circuit and district courts to undermine the heavy presumption in favor of the ordinary meaning of claim language.

This Court is presented with a unique opportunity to provide direction to the lower courts in determining the scope of patent rights. Without a review by this Court, the Federal Circuit will continue to whittle away at the ordinary meaning of patent claim language, redrafting patent claims to achieve a particular result — all under the guise of the court's duty to construe claims under *Markman*.

Allowing the lower courts to redefine claim language based solely on supposed remarks in the file history inconsistent with the patent document as a whole, to be sure, unjustly makes the reward for the patent disclosure ambiguous at best. In short, it is contrary to the purposes of the patent system to torture the plain language of patent claims to obtain a desired result.

CONCLUSION

For the foregoing reasons, the petition for writ of certiorari should be granted.

Respectfully submitted,

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APPENDIX

APPENDIX A — OPINION OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT DATED AND DECIDED JUNE 2, 2000

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Nos. 99-1252, -1253

ARTHUR S. KOENIG AND MDI LABS, INC.,

Plaintiff-Appellants,

v.

FUGRO-MCCLELLAND (SOUTHWEST), INC., and PHILIP KING,

Defendants-Cross Appellants.

DECIDED: June 2, 2000

Before PLAGER, CLEVENGER, and SCHALL, *Circuit Judges*.

CLEVENGER, *Circuit Judge*.

Arthur S. Koenig and MDI Labs, Inc. ("Koenig") appeal the judgment of the United States District Court for the Western District of Texas granting summary judgment that the accused product of Fugro-McClelland (Southwest), Inc. and Philip King ("Fugro") did not infringe, literally or under the doctrine of equivalents, the asserted claims of Koenig's United States Patent No. 5,076,392 ("the '392 patent"), and

that Fugro did not misappropriate its trade secrets. Fugro cross-appeals the grant of summary judgment that the '392 patent was not invalid under 35 U.S.C. § 112 (1994) for failure to disclose the best mode, or under the on-sale or public use bars of 35 U.S.C. § 102(b). Because under the proper claim construction, Fugro's device does not infringe, either literally or under the doctrine of equivalents, and because the district court correctly held that Fugro did not misappropriate the asserted trade secrets, we *affirm*.

I

Koenig and Fugro are both in the business of sampling soil, primarily from beneath the foundations of buildings. Soil samples are necessary to provide geological information about the composition of the material beneath the building, information that is critically important in diagnosing and repairing buildings with slipping foundations caused by soil movement beneath the foundation. Drilling and sampling from within a building, however, poses certain problems. For example, a smaller, portable machine must be used, and the machine must be secured to the foundation so that the powerful force used while inserting and extracting the sampling tube does not drive the machine out of or into the hole, respectively. This lawsuit generally concerns portable drilling machines in which the drilling derrick is anchored firmly to the hole itself.

A

Koenig owns the '392 patent, entitled "Method and Apparatus for Forcing a Member Through a Material such

as Soil and Obtaining Samples Therefrom." The patent describes a portable drilling device, also known as the "geosampler," with four components: a derrick, a hydraulic drilling ram, an anchoring mechanism for anchoring the derrick firmly in place above the hole, and a means to connect the derrick to the anchoring mechanism. The patented invention collects soil samples from beneath a building foundation by first drilling a hole through the foundation, firmly affixing the anchoring mechanism within the hole, attaching the drilling machine to the anchoring device, then forcing a sampling tube through the underlying soil to collect a sample.

For the purposes of this decision, we must focus on the anchoring mechanism, claimed in several different ways in asserted claims 1-27. Claim 1 is representative:

> An apparatus for forcing a member within a material comprising:
>
> means for selecting a line of action along which a member is to be forced within a material;
>
> means mounted to said line of action selecting means for forcing the member within the material along the line of action when activated;
>
> *means* positionable in a hole which extends only part way through the material within which the member is to forced [sic] *for positively engaging* the material within which the member is to be forced and having an opening therethrough for

because the "way" and "result" prongs are the same under the section 112, paragraph 6 and doctrine of equivalents tests), the accused device in this case may still infringe under the doctrine of equivalents because we affirmed the district court's holding of no literal infringement based on a lack of identity of function. *See WMS Gaming, Inc. v. International Game Technology*, 184 F.3d 1339, 1353, 51 USPQ2d 1395 (Fed. Cir. 1999) (considering the issue of infringement under doctrine of equivalents because function of claimed and accused devices were not identical). The difference between the analysis of section 112, ¶ 6 statutory equivalents and the doctrine of equivalents as applied to section 112, ¶ 6 claim elements is simply that section 112, ¶ 6 statutory equivalence requires identity of function, while the doctrine of equivalents requires a substantially similar function. *See Kemco Sales*, 2000 WL 354768, *9; *Al-Site*, 174 F.3d at 1320-21, 50 USPQ2d at 1167-68 (tests for infringement under section 112, ¶ 6 and doctrine of equivalents are not co-extensive); *Chiuminatta*, 145 F.3d at 1310, 46 USPQ2d at 1758 (same).

No reasonable jury could find that Fugro's device, which clamps the foundation between a top plate resting on top of the slab and a bottom plate resting against the bottom of the slab, performs substantially the same function as the claimed function, preventing axial movement by interacting with a groove or discontinuity in the wall of the hole via a lip or lip-like structure. *See Warner-Jenkinson*, 520 U.S. at 39 n.8, 41 USPQ2d at 1875 n.8 ("Where the evidence is such that no reasonable jury could determine two elements to be equivalent, district courts are obliged to grant . . . summary judgment."). Accordingly, we affirm the district court's grant of summary judgment that Fugro's device does not infringe

claims 1-11, 18-20 and 22 under the doctrine of equivalents. Because we affirm the grant of summary judgment, we need not reach Fugro's argument that prosecution history estoppel bars application of the doctrine of equivalents.

At oral argument, Fugro stated it would withdraw its counterclaim if this court affirmed the district court's grant of summary judgment of no infringement, either literal or under the doctrine of equivalents. Accordingly, we dismiss Fugro's cross-appeal that the district court erred when it denied Fugro's motion for summary judgment that the '392 patent was invalid.

IV

The final issue we must consider is Koenig's claim that Fugro misappropriated its trade secrets under the guise of evaluating Koenig's and MDI's ability to perform work for Fugro. Specifically, Koenig accuses Fugro of misappropriating (1) his entire "package" of business and technical operating procedures; (2) proprietary information concerning the composition of cement in the Corpus Christi, Texas area; and (3) Koenig's "secret" billing procedures.

Under Texas law, a trade secret misappropriation requires the existence of a trade secret, a breach of a confidential relationship or improper discovery of the trade secret, and use of the trade secret. *See Plains Cotton Coop. Assn. v. Good Pasture Computer Serv., Inc.*, 807 F.2d 1256, 1262 (5th Cir. 1987). A trade secret is any formula, pattern, device or compilation of information used in one's business which gives an opportunity to obtain an advantage over

competitors who do not know or use it. *K & G Oil Tool & Serv. Co. v. G & G Fishing Tool Serv.*, 314 S.W.2d 782, 790 (Tex. 1958). A trade secret need not be completely secret, and the fact that it may be discovered by fair means does not deprive the owner of his right to protection from one who secures the knowledge by unfair means. *See Brown v. Fowler*, 316 S.W.2d 111, 115 (Tex. App. 1958). However, information that is a matter of public knowledge or of common knowledge in the trade cannot be a trade secret. *See Creole Prod. Servs. v. Harper*, 640 S.W.2d 727, 730 (Tex. App. 1982).

The district court granted summary judgment of no trade secret misappropriation on the ground that Koenig failed to present summary judgment proof from which a reasonable jury could conclude that the information was entitled to trade secret status. The district court found that Koenig did not produce any evidence that Fugro used his overall business package, nor that his methods were not known or used in the industry. The court further found that Koenig did not demonstrate that the information about cement in Corpus Christi or his billing procedures were anything but common knowledge. We discern no error in either the district court's reasoning or its conclusion, and therefore affirm the district court's grant of summary judgment that Fugro did not misappropriate Koenig's alleged trade secrets.

Appendix A

CONCLUSION

Because under the proper claim construction, Fugro's device does not infringe, either literally or under the doctrine of equivalents, and because the district court correctly held that Fugro did not misappropriate the asserted trade secrets, we affirm. Because Fugro withdrew its cross-appeal, we dismiss Fugro's cross-appeal that the district court erred when it denied Fugro's motion for summary judgment that the '392 patent was invalid.

COSTS

No costs.

APPENDIX B — ORDER OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT DENYING PETITION FOR REHEARING DATED AND FILED JUNE 29, 2000

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

ORDER

Before PLAGER, Circuit Judge, CLEVENGER, Circuit Judge, and SCHALL, Circuit Judge.

A petition for rehearing having been filed by the APPELLANTS

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for rehearing be, and the same hereby is, DENIED.

The mandate of the court will issue on July 6, 2000.

FOR THE COURT,

s/ Jan Horbaly
Jan Horbaly
Clerk

Dated: June 29, 2000

KOENIG V FUGRO-MCCLELLAND INC, 99-1252,-1253 (DCT – 93-CV-976)

APPENDIX C — ORDER OF THE UNITED STATES DISTRICT COURT FOR THE WESTERN DISTRICT OF TEXAS, SAN ANTONIO DIVISION DATED AND FILED JANUARY 27, 1998

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
SAN ANTONIO DIVISION

CIVIL NO. SA-93-CA-976

ARTHUR S. KOENIG and MDI LABS, INC.,

Plaintiffs,

v.

FUGRO-MCCLELLAND (SOUTHWEST), INC., and PHILIP KING,

Defendants.

ORDER

Came on this date for consideration by the Court the Report and Recommendation filed by United States Magistrate Judge Nancy Stein Nowak on June 30, 1997,[1] which recommends that the Motion for Summary Judgment of the Defendants be granted with the exception of Defendants' request for attorney's fees and that the Motion for Partial Summary Judgment of Plaintiffs be denied. Also before the Court are the objections filed by Plaintiffs on July 14, 1997[2] and the Plaintiffs' Revised Objections filed on July 21, 1997,[3] the Defendants' Response

1. Docket Entry No. 142.

2. Docket Entry No. 143.

3. Docket Entry No. 144.

to Plaintiffs' objections filed on July 30, 1997,[4] the Plaintiffs' Reply to Defendants' Response filed on August 20, 1997,[5] and Defendants' Surreply filed on September 2, 1997.[6] The Court, having conducted an independent review of the record in this case and having made a de novo determination with respect to those portions of the Magistrate Judge's Memorandum and Recommendation to which objections have been made, as required by 28 U.S.C. §636(b)(1)(C), hereby accepts and adopts the Magistrate Judge's findings and recommendation as its own.

Accordingly, it is ORDERED that the Defendants' Motion for Summary Judgment[7] be, and the same is hereby, GRANTED with the exception of Defendants' request for attorney's fees.

IT IS FURTHER ORDERED that the Plaintiffs' Motion for Partial Summary Judgment of Literal Infringement[8] be, and the same is hereby, DENIED.

SIGNED this the 27th day of January, 1998.

s/ D.W. Suttle
D.W. SUTTLE
Senior United States District Judge

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4. Docket Entry No. 146.

5. Docket Entry No. 148.

6. Docket Entry No. 149.

7. Docket Entry No. 24.

8. Docket Entry No. 82.

Supreme Court, U.S.
FILED
NOV 16 2000
CLERK

(2)

No. 00-500

In The

Supreme Court of the United States

ARTHUR S. KOENIG and MDI LABS, INC.,

Petitioners,

v.

FUGRO-MCCLELLAND (SOUTHWEST), INC. and PHILIP KING,

Respondents.

On Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

BRIEF IN OPPOSITION

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QUESTION PRESENTED

1. Did the Court of Appeals for the Federal Circuit err when it construed an express limitation in a patent claim to have the same meaning that the patent applicant stressed in the "prosecution history" of his patent?

PARTIES TO THE PROCEEDING

Fugro-McClelland (Southwest), Inc. has changed its corporate name to Fugro South, Inc. The parent corporations and publicly held companies that own 10% or more of the stock of Respondent Fugro-McClelland (Southwest), Inc. are:

Fugro NV (a Netherlands company traded on the Amsterdam Exchange),

Fugro Consultants International NV,

Fugro (USA) Inc.,

Orguf Holding, Inc., and

Fugro South, Inc. (formerly Fugro-McClelland (Southwest), Inc.).

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RULES

Sup. Ct. R. 10 2

BRIEF IN OPPOSITION

Fugro-McClelland (Southwest), Inc. and Philip King (hereinafter "Respondents") request that the Court deny the petition for writ of certiorari in this case. The unpublished Federal Circuit opinion presents no conflict or ruling that could justify the Court's review.

STATEMENT OF THE CASE

Petitioners sued Respondents for patent infringement in 1993. After complete discovery, the magistrate judge construed the claims of the patent and compared them to Respondents' machines. Since the material features of Respondents' machines were not disputed, the case was decided on summary judgment. The magistrate judge concluded that Respondents had not infringed. Petitioners sought review by the district court, and the district court's independent conclusion was the same as the magistrate's. On December 29, 1998, the district court made its summary judgment in favor of Respondents a final judgment.

Petitioners appealed. A three-judge panel of the Court of Appeals for the Federal Circuit reviewed the same materials that the district court had reviewed, namely, the patent's claims, specification, and prosecution history,[1] and again construed the patent's disputed

[1] The record of proceedings in the Patent and Trademark Office is referred to as the "file wrapper," *Autogiro Co. of America v. United States*, 384 F.2d 391, 398 (Ct. Cl. 1967), or alternatively as the "prosecution history," or the "file history." *See, e.g., CAE*

claim limitation. The resulting unpublished opinion affirming the district court (reproduced at Appendix A of Petitioners' Brief) construed the disputed claim limitation to have the same meaning determined by the magistrate judge and by the district court.

SUMMARY OF THE ARGUMENT

Petitioners' reasons for review are not "compelling" as required by Sup. Ct. R. 10. The issue of law at the crux of Petitioners' arguments – whether the prosecution history of a patent may be used to construe a claim limitation – has already been decided affirmatively by the Court. In its nearly twenty years of existence, the Court of Appeals for the Federal Circuit has never strayed from this bedrock claim construction principle, and Petitioners' statement of conflicting decisions is made without any authority in support. In this particular case, five different judges have followed the claim construction principles delineated by this Court, and all of those judges arrived at the same claim construction. Further review would be a waste of time.

Screenplates, Inc. v. Heinrich Fiedler GmbH & Co. KG, 224 F.3d 1308, 1318 (Fed. Cir. 2000)

ARGUMENT

I. This Court Has Already Decided The Legal Issue.

In *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 116 S. Ct. 1384 (1996), the Court decided *who* should undertake the "mongrel practice" of construing a patent's claims. 517 U.S. at 378, 116 S. Ct. at 1390. *How* the claim construction is to be accomplished had been decided long before. "It is, of course, well settled that an invention is construed not only in light of the claims, but also with reference to the file wrapper or prosecution history in the Patent Office." *Graham v. John Deere Co.*, 383 U.S. 1, 33, 86 S. Ct. 684, 702 (1966) (citations omitted). The claim construction principle recited in *Graham* is almost as old as the patent system itself. *Crawford v. Heysinger*, 123 U.S. 589, 602, 8 S. Ct. 399, 406 (1887) ("The file-wrapper and contents in the matter of the reissue [patent] are part of the evidence in the case, and throw light upon what should be the proper construction of claims 1 and 2.").

The Court has consistently applied the long-standing principle that a patent's prosecution history may supply a special definition to a claim limitation. In *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211, 61 S. Ct. 235 (1940), the Court decided the "question whether, in the light of the patent office history of the . . . patent, . . . the court below, in construing the specifications and claims, erroneously included one element . . . in the patented combination." 311 U.S. at 212, 61 S. Ct. at 236. The Court, relying on the file wrapper history, concluded that the claim limitation at issue in *Schriber-Schroth* had a special meaning *different from* the meaning that would have been determined from "the specifications and claims of the

patent [if it] were to be interpreted without reference to its file wrapper history . . . ." 311 U.S. at 217, 61 S. Ct. at 238. The Court has relied on the prosecution history to find special definitions in other patent cases as well. *See, e.g., Weber Elec. Co. v. E. H. Freeman Elec. Co.*, 256 U.S. 668, 676-78, 41 S. Ct. 600, 603 (1921) (relying on remarks in the "file wrapper" which "require that the expressions in the fourth [patent] claim . . . must be restricted to a . . . " special meaning); *Keystone Driller Co. v. Northwest Eng'g Corp.*, 294 U.S. 42, 46-48, 55 S. Ct. 262, 264 (1935) (relying on remarks in the file wrapper to "hold, in view of the prior art and of the file wrapper, the petitioner is not entitled to a broad reading of the claim" because to do so "would be contrary to the limitation which the Patent Office file wrapper shows the applicant placed upon his asserted invention."); *I.T.S. Rubber Co. v. Essex Rubber Co.*, 272 U.S. 429, 440-44, 47 S. Ct. 136, 140-41 (1926) (construing claim limitation whose meaning was "limited by the proceedings in the Patent Office").

II. The Court Of Appeals For The Federal Circuit Has Consistently Relied On A Patent's Prosecution History To Construe Claims.

Many Federal Circuit panels have mandated that patent claims should be construed in light of the prosecution history. *E.g., Desper Products, Inc. v. QSound Labs, Inc.*, 157 F.3d 1325, 1333 (Fed. Cir. 1998) ("To determine the meaning and scope of a claim, we first examine the claim language, the specification, and, if in evidence, the prosecution history.") (citations omitted); *Litton Systems, Inc. v. Honeywell, Inc.*, 140 F.3d 1449, 1453 (Fed. Cir. 1998) ("In

a literal infringement analysis, prosecution history is relevant to claim coverage.") (quoting *York Prods., Inc. v. Central Tractor Farm & Family Ctr.*, 99 F.3d 1568, 1575 (Fed. Cir. 1996)); *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1476 (Fed. Cir. 1998) ("The proper construction of claims is based upon the claim language, the written description portion of the specification, the prosecution history, and if necessary to aid the court's understanding of the patent, extrinsic evidence."); *Regents of Univ. of California v. Eli Lilly & Co.*, 119 F.3d 1559, 1572 (Fed. Cir. 1997); *CVI/Beta Ventures, Inc. v. Tura LP*, 112 F.3d 1146, 1152 (Fed. Cir. 1997). Often, the prosecution history is the critical evidence used to determine the proper claim construction.

> [T]he court may also consider the prosecution history of the patent, if in evidence. . . . This history contains the complete record of all the proceedings before the Patent and Trademark Office, including any express representations made by the applicant regarding the scope of the claims. As such, the record before the Patent and Trademark Office is often of critical significance in determining the meaning of the claims.

Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582-83 (Fed. Cir. 1996) (citations omitted).

Special definitions advanced in the prosecution of a patent are given effect in construing claim limitations. *Amhil Enterprises Ltd. v. Wawa, Inc.*, 81 F.3d 1554, 1559 (Fed. Cir. 1996) (construing a claim limitation "substantially" in light of the prosecution history); *Southwall Techs., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1576 (Fed. Cir.

1995) (construing a claim limitation "sputter-deposited dielectric" in light of the prosecution history).

III. Petitioners' Authorities Do Not Support The Contention That Special Definitions Must Be Found Only In The Specification.

Petitioners' novel argument that a special definition for a claim limitation must be found *only* in the specification of the patent is not supported by any of the authorities cited in their brief.[2] Petition at 4-5. Petitioners' reliance on *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995), *aff'd*, 517 U.S. 370, 116 S. Ct. 1384 (1996), is particularly misplaced. Petition at 4. *Markman* adopted the approach explained in *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384 (Fed. Cir. 1992), which held that "terms in a claim are given their ordinary meaning to one of skill in the art unless it appears from the patent *and file history* that the terms were used differently by the inventors." 952 F.2d at 1387 (emphasis added). Furthermore, Petitioners' narrow quote from *Markman* to avoid interpretation based on prosecution history not only ignores *Intellicall*, it disingenuously ignores the rest of *Markman* that fatally disproves their argument:

> To ascertain the meaning of claims, we consider three sources: The claims, the specification, and the *prosecution history*. . . . To construe claim language, the court should also consider the

---

[2] Incredibly, after seven years of litigation, Petitioners urge for the first time that prosecution history is not a proper source for determining the meaning of a claim limitation.

> patent's *prosecution history*, if it is in evidence. . . . This 'undisputed public record' of proceedings in the Patent and Trademark Office is of primary significance in understanding the claims. . . . The court has broad power to look as a matter of law to the *prosecution history* of the patent in order to ascertain the true meaning of language used in the patent claims . . . .

52 F.3d at 979-980 (citations and text omitted) (emphasis added).

Petitioners' reliance on *Markman* is also surprising because the Court's *Markman* decision affirmed a claim construction which had been determined by consulting the prosecution history of the patent in that case. *Markman v. Westview Instruments, Inc.*, 772 F. Supp. 1535, 1537 (E.D. Pa. 1991), *aff'd*, 52 F.3d 967 (Fed. Cir. 1995), *aff'd*, 517 U.S. 370, 116 S. Ct. 1384 (1996) (rejecting patentee's litigation-inspired construction because it was contrary to "the obvious meaning intended by the patentee, determined from the specifications, the drawings *and the file histories* of the . . . patent-in-suit.") (emphasis added).

Of the other five cases cited on page 5 of the Petition, three expressly acknowledge the propriety of relying on the prosecution history to construe claim limitations. *See Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1477-78 (Fed. Cir. 1998); *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994); *Intellicall*, 952 F.2d at 1388. Neither of Petitioners' two other cases includes any indication that a court may *not* examine the prosecution history to construe a claim limitation – they are merely silent as to that point. *See Gentex Corp. v. Donnelly Corp.*, 69 F.3d 527 (Fed. Cir. 1995); *Beachcombers Int'l, Inc. v. Wildewood Creative*

Prods., Inc., 31 F.3d 1154 (Fed. Cir. 1994). Petitioners have cited no authority to support the unusual notion that it is improper to consider the prosecution history in construing a claim limitation. Therefore, despite Petitioners' statements to the contrary, no conflict exists with the Court's precedent or within the Federal Circuit.[3]

IV. Petitioners Present No Reason To Change The Well-Settled Principles.

Petitioners have not presented a compelling reason to change the law followed in *Markman* and its predecessors. Patentees, like Arthur Koenig in this case, who assert a restricted meaning for a claim limitation to convince the Patent Office to allow the patent, should never be permitted to back away from that restriction and construe the patent more broadly when the patent is asserted against alleged infringers. "Claims may not be construed one way in order to obtain their allowance and in a different way against accused infringers." *Southwall*, 54 F.3d at 1576.

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[3] Furthermore, Petitioners' far-fetched notion that the prosecution history cannot supply a special definition to a claim limitation is not even determinative in this case. Petitioners failed to mention that the definition stressed in the prosecution history was quoted directly *from the specification* of the Koenig patent. *See*, Appendix 1 at App. 2 where "[a]pplicant desires to call attention to the definition *in the specification* of the phrases 'reactive force' and 'positive engagement' . . . " (emphasis added).

V. The Appellate Claim Construction Did Not Cause Any Surprise Or Unfair Prejudice.

Petitioners' last complaint, that they were denied the opportunity to "present evidence and create a fact issue on infringement" because of the appellate court's alleged "new claim construction" is spurious. Petition at 4, 7 (footnotes 3 and 4). The magistrate judge, the district court, and the appellate court adopted the claim construction that Respondents have advanced consistently since 1994. *See* Respondents' 1994 claim construction arguments in Petitioners' Exhibit A at 14 (which Petitioners filed with the Court under seal); the magistrate judge's 1997 claim construction in Exhibit A at 16; the district court's 1998 claim construction in Appendix C at 24a; and the Federal Circuit's year 2000 claim construction in Appendix A at 14a. Petitioners' cry of unfair surprise is incredible in light of six years' and five judges' worth of consistent claim construction in this case.

CONCLUSION

Petitioners have not presented a compelling reason or need to revisit the question of whether the prosecution history of a patent may be consulted for guidance about the meaning of an express limitation in a claim of that patent. The law on this point is well-settled and the courts are not in conflict. The Court need not engage itself in yet another round of the "mongrel practice" of construing patent claims merely because Petitioners are

unhappy with all of the decisions below. The petition should be denied.

Respectfully submitted,

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APPENDIX 1 – PROSECUTION HISTORY – FEBRUARY 5, 1990 SUBMISSION TO THE UNITED STATES PATENT AND TRADEMARK OFFICE

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Arthur S. Koenig	§	DOCKET NO.: KOEA, 002 Formerly: M-07033.2
SERIAL NO.: 07/250,371	§	GROUP ART NO.: 221
FILED: September 28, 1988	§	EXAMINER: B. Steinberger
FOR: METHOD AND APPARATUS FOR FORCING A MEMBER THROUGH MATERIALS SUCH AS SOIL AND OBTAINING SAMPLES	§	

* * *

RESPONSE B (REVISED)

The Honorable Commissioner
of Patents and Trademarks
Washington, D.C. 20231

Sir:

Applicant responds to the Office Action of June 1, 1989 in this revised Response B as follows. This revised Response B is intended to substitute for the original

Response B filed on November 1, 1989, and only the amendments set out herein are to be entered in the case. A request for a two month extension of the time to respond in accordance with 37 C.F.R. §1.136(a), and an authorization to charge the Deposit Account of Applicant's Attorney's firm for the required fee, were enclosed with the original Response B.

. . .

REMARKS

. . .

Before discussing the §§102 and 103 rejections, Applicant desires to call attention to the definition in the specification of the phrases "reactive force" and "positive engagement" which appear in the claims. As taught so eloquently in Autogiro Company of America v. U.S. (384 F.2d 391, 397 (Ct. Claims 1967)),

> "an invention exists most importantly as a tangible structure or a series of drawings. A verbal portrayal is usually an afterthought written to satisfy the requirements of patent law. This conversion of machine to words allows for unintended idea gaps which cannot be satisfactorily filled. Often the invention is novel and words do not exist to describe it. * * * To overcome this lag, patent law allows the inventor to be his own lexicographer [citations omitted]."

These definitions, therefore, represent Applicant's attempt to fill these "unintended idea gaps", e.g., they are the words chosen to describe an invention which is novel, and it is believed that reference to them is essential to an understanding of how the claims as filed define an invention which is not anticipated by the cited references.

As stated at page 8, beginning at line 1, "positive engagement" of strata 102 is achieved by the interaction of the collar 200 with a discontinuity, such as the groove 216, in the wall of hole 110 which "prevents axial movement of collar 200 in hole 110 regardless of the direction of the reactive forces applied thereto." That "axial movement" would, of course, be movement along the line of action of a member forcing means such as hydraulic cylinder 326.

The phrase "reactive force" is defined at various places throughout the specification. For instance, at page 11, line 2, it is stated that the collar 200 resists the reactive forces "which cause movement either away from or down into strata 102 when force is applied thereto" by activation of the hydraulic cylinder 326. On that same page, at lines 18-20, it is stated that collar 200 engages the discontinuity, or groove 216, in the wall of hole 110 "to transmit the [reactive] force exerted by the force exerting apparatus to which collar 200 is engaged", and on page 14, lines 9-15, it is pointed out that the mechanism for transmitting the reactive force in the strata 102 "is that of introducing an interference to carry shear forces between

the wall of the hole 110 and collar 200 . . . to cause 'lock up' to be achieved."

. . .

Respectfully submitted,

/s/

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ATTORNEY OF RECORD

Dated: Feb 2, 1990

. . .

(3)

Supreme Court, U.S.
FILED
DEC 29 2000
OFFICE OF THE CLERK

No. 00-500

IN THE

Supreme Court of the United States

ARTHUR S. KOENIG and MDI LABS, INC.,

Petitioners,

v.

FUGRO-McCLELLAND (SOUTHWEST), INC. and PHILIP KING,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

REPLY BRIEF

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STATEMENT PURSUANT TO RULE 29.6

With respect to Petitioner MDI Labs, Inc., there is no parent corporation or any publicly held company that owns ten percent or more of the Petitioner's stock.

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Petitioners, Arthur S. Koenig and MDI Labs, Inc. (collectively referred to as "Koenig"), request that the Court grant the Petition for Writ of Certiorari in this case. This Reply Brief is addressed to points raised in Respondents' Brief in Opposition.

ARGUMENT

It is clear that the public needs guidance in how to read patents to achieve the proper "notice effect" for which they are intended. This Court's recent decision in *Markman* so emphasized. *See Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 116 S. Ct. 1384, 134 L. Ed. 2d 577 (1996). In the present case, the Federal Circuit read special definitions of words from the file history — normally unknown to the patent reader — into the patent document itself. Petitioner seeks a rule that "special definitions" must be included in the patent specification itself, otherwise the normal meaning of words control. Such a rule brings certainty and uniformity where it does not now exist.

I. Respondents Fail to Address the Important Question Presented by Petitioners

Advocacy by ignoring the question presented in the Petition permeates Respondents' Opposition Brief. Respondents characterize the pertinent question as "whether the prosecution history of a patent may be used to construe a claim limitation." Brief in Opposition at 2. About this issue of law there is no dispute. It is "well settled that an invention is construed not only in light of the claims, but also with reference to the file wrapper or prosecution history in the Patent Office." *Graham v. John Deere Co.*, 383 U.S. 1, 33, 86 S. Ct. 684, 702 (1966). This is not the relevant question before the Court, however.

Petitioners do not contend that the Court should ignore the prosecution history in construing patent claims. Rather, Petitioners submit that the patentee who chooses to be his own lexicographer must alert the public to his "special definition" in the patent specification. Simply put, the issue presented is not whether the prosecution history plays a role in claim construction — which it does — but whether any special definition given to a word must be clearly defined in the specification.

Respondents' reliance upon legal authorities is misplaced. The case law from this Court upon which Respondents rely does not address the question of whether a special definition can be provided solely in the prosecution history. For example, in *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211, 61 S. Ct. 235 (1940), the patentee did not set forth a special definition in the prosecution history, but merely cancelled certain claims in view of the prior art. The Court properly held that the cancellation of claims resulted in a disclaimer of claim scope. *Id.* at 220, 61 S. Ct. at 239. This is nothing more than an application of doctrine of prosecution history estoppel. *Id.* It provides no guidance, however, as to whether a patentee who chooses to be a lexicographer can bury a special definition in the file history. Nor do any of the other authorities upon which Respondents rely. *See, e.g., Weber Elec. Co. v. E.H. Freeman Elec. Co.*, 256 U.S. 668, 676-78, 41 S. Ct. 600, 603 (1921) (recognizing that the patentee had narrowed his property right by amending the claims to recite a "specific structure"); *Keystone Driller Co. v. Northwest Eng'g. Corp.*, 294 U.S. 42, 47-49, 55 S. Ct. 262, 264-65 (1935) (construing the property grant based upon claims cancelled with new ones submitted with additional limitations); *I.T.S. Rubber Co. v. Essex Rubber Co.*, 272 U.S. 429, 443-44, 47 S. Ct. 136, 141 (1926)

(construing claims based upon limitations imposed by the inventor introduced after rejection of the application). Such cases merely stand for the well-established principle that a patent applicant, compelled to narrow his claim by the addition of a new limitation, cannot thereafter broaden his claim by dropping such limitation. *I.T.S. Rubber*, 272 U.S. at 443, 47 S. Ct. at 141. But in none of the cases did the patentee set forth a "special definition" for a claim term at odds with the conventional definition.

In the present case, the Patent Examiner did *not* require Petitioner Koenig to amend his claims before issuing the patent. And yet, the Federal Circuit ascribed a special definition to the term "positively engaging" based solely on remarks in the file history. The cases cited by Respondents are therefore inapposite and provide no guidance whatsoever in deciding this and other cases sure to follow.

II. The Conflict in the Law Requires an Exercise of the Court's Supervisory Power

Respondents' argument that there is no conflict in the case law because the courts have consistently relied on a patent's prosecution history to construe claims misses the point. Of course, the prosecution history plays an important role in construing claims. The relevant inquiry, however, is whether a patentee who chooses to be his own lexicographer must include his special definition in the patent document itself.

The Court need look no further than a handful of panel decisions from the Federal Circuit to see that the conflict is real. While some panels have clearly held that any special definition of a claim term that departs from its ordinary meaning must be clearly set forth *in the patent specification*,

e.g., Multiform Desiccants, Inc. v. Medzam, Ltd., 133 F.3d 1473, 1477 (Fed. Cir. 1999) (recognizing that "a special meaning . . . must be sufficiently clear *in the specification* that any departure from common usage would be so understood by a person of experience in the field of the invention") and *Gentex Corp. v. Donnelly Corp.*, 69 F.3d 527, 530 (Fed. Cir. 1995) (emphasizing that "[w]ords in claims are to be given their ordinary meaning in the absence of indication *in the patent* to the contrary"), other panels have shown no reluctance to stray from the ordinary meaning based upon statements made only in the prosecution history, *e.g., K-2 v. Saloman S.A.*, 191 F.3d 1356, 1363 (Fed. Cir. 1999) (noting that "a different meaning clearly and deliberately set forth in the intrinsic materials — the written description *or the prosecution history* — will control"); *Transmatic, Inc. v. Gulton Indust., Inc.*, 53 F.3d 1270, 1277 (Fed. Cir. 1995) (remarking that "claim terms are given their ordinary and accustomed meaning unless examination of the . . . prosecution history . . . indicate[s] otherwise").

It was for the sake of uniformity that Congress created the Federal Circuit as an exclusive appellate court for patent cases. H.R. Rep. No. 97-312, p. 20 (1991). The Federal Circuit's treatment of its own precedent in this matter threatens the very uniformity of patent law that Congress sought to foster by creating the circuit.

That the Federal Circuit has been riddled with conflict in recent years is no justification.[1] Although this Court has

1. The judiciary has freely acknowledged that conflicts exist in the Federal Circuit's patent law, causing difficulty to both the patent bar and its clients. *See* The Honorable Arthur J. Gajarsa, Conflict of the Federal Circuit, addressed to the San Diego

(Cont'd)

viewed it as "primarily the task of a court of appeals to reconcile its internal difficulties," *Wisniewski v. United States*, 353 U.S. 901, 902, 77 S. Ct. 633, 1 L. Ed. 2d 658 (1957), the Federal Circuit has shown no willingness to do so. As evidenced by this case among others, decisions from the Federal Circuit have departed so far from the principles of *stare decisis* as to require an exercise of this Court's supervisory power.[2] Without it the Federal Circuit will continue to whittle away at the ordinary meaning of patent claim language, rendering the property right a hollow one.

(Cont'd)
Intellectual Property Law Association (January 14, 1999), to the Orange County Patent Law Association (January 15, 1999) and to Los Angeles Intellectual Property Law Association (January 16, 1999). *See also* William C. Rooklidge & Matthew F. Weil, Judicial Hyperactivity: The Federal Circuit's Discomfort With Its Appellate Role, 15 Berkeley Tech. L.J. 725 (2000); William C. Rooklidge & Matthew F. Weil, En Banc Review, Horror Pleni; and the Resolution of Patent Law Conflicts, 40 Santa Clara L. Rev. 787 (2000).

2. Principles of *stare decisis* as applied to patent claim interpretation are of critical importance in the wake of *Markman*. When the "established rules" of claim construction are applied differently by different panels of the Federal Circuit, uncertainty results — the very uncertainty that *Markman* sought to avoid by confiding the duty of claim construction to a court rather than to a jury with a corresponding danger of inconsistency and error. *See Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 390, 116 S. Ct. 1384, 1396, 134 L. Ed. 2d 577 (1996) (recognizing that "uniformity in the treatment of a given patent" is "an independent reason to allocate all issues of construction to the court").

III. Respondents Refuse to Acknowledge that the Claim Construction Changed Throughout the Litigation, Denying Petitioners the Normal Protections Afforded a Nonmovant in Summary Judgment Procedures

Respondents baldly assert that "[t]he magistrate judge, the district court, and the appellate court adopted the claim construction that Respondents have advanced consistently since 1994." Respondents' Brief in Opposition at 9. The record is clear on this point, however. As illustrated below, the meaning of "positively engaging" changed at every turn.

> • ***Respondents' Interpretation***
> "The term 'positive engagement' means that the anchoring device is locked up against the wall of the core hole through the concrete slab and resists movement in both the up and the down direction." Respondents' Brief in Support of Motion For Summary Judgment on Patent Issues, p. 5.
>
> • ***District Court's Interpretation***
> "Positive engagement" requires "both prevention of up and down movement and lock-up with the wall of the hole." Memorandum and Recommendation filed under seal, p. 12.
>
> • ***Federal Circuit's Interpretation***
> "Positive engagement" means "preventing axial movement by interacting with a grove or discontinuity in the wall of the hole via a lip or lip-like structure." App. A, p. 16a.

Once apprised of the magistrate judge's interpretation of the term "positively engaging" in her recommendation to the district court, Petitioners submitted additional affidavit testimony from persons skilled in the art necessary to create a genuine issue of material fact should the district court ultimately adopt the magistrate's claim construction — which it did.[3] The Federal Circuit then went beyond the mere "prevention of up and down movement and lock-up with the wall of the hole" to require "interacting with a groove or discontinuity in the wall of the hole via a lip or lip-like structure." App. A, p. 16a. Without such a narrowing construction, the summary judgment could not have been affirmed in view of the affidavit testimony of record.

Here is the rub: Petitioners were never provided an opportunity to present evidence as to infringement in view of the Federal Circuit's modified claim construction — a construction which was far from merely a slight or foreseeable variance from those urged by the litigants, since the affidavit testimony that created the fact issue under the first construction no longer did so under the second. By adopting a different interpretation of the claims, the Federal Circuit effectively required the Petitioners to litigate during summary judgment proceedings not only its opponents' position, but also the unknowable position of the appellate court. Consequently, Respondents won based upon a claim

---

3. The district court construed "positively engaging" to require "both prevention of up and down movement and lock-up with the wall of the hole." To create an issue of fact on infringement, Koenig had submitted affidavit testimony to establish that "[t]he Fugro anchorage device prevents movement in the up and down direction" (Koenig 10/24/97 Affidavit) and "Fugro's device literally locks up with the wall of the hole" (Bailey 7/14/97 affidavit). And yet this evidence was ignored by the district court.

interpretation that they could never have raised on appeal because the interpretation was not argued below. The present case is not an anomaly. The Federal Circuit has disposed of other cases in this fashion. *See, e.g.*, *Exxon Chem. Patents v. Lubrizol Corp.*, 64 F.3d 1553, 1560 (Fed. Cir. 1995) (remarking that although the claim interpretation was at a "slight variance from that urged" by the parties, there was no purpose for the jury in the infringement analysis).

The normal protections afforded the nonmovant in summary judgment proceedings are no less important in patent cases. Where the Federal Circuit chooses to adopt its own claim construction, fairness (and the law) dictates that the parties are given an opportunity to present evidence on infringement. Otherwise, the Federal Circuit will continue to assume the role of fact-finder based upon an incomplete record. This cannot and should not be the law.

CONCLUSION

For all of the foregoing reasons, the Petition for Writ of Certiorari should be granted.

Respectfully submitted,

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